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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/612,216	07/02/2003	Mordechai Beyar	687-411	5735
34205	7590	10/18/2004	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY LLP			FARAH, AHMED M	
45 SOUTH SEVENTH STREET, SUITE 3300			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402			3739	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/612,216

Applicant(s)

BEYAR ET AL.

Examiner

Ahmed M Farah

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/02/03</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION*****Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 11 and 13-18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of prior U.S. Patent No. 6,616,653 B2. This is a double patenting rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Costello et al. U.S. Patent No. 5,322,507.

Costello et al. disclose a non-implantable device for the treatment of prostate, the device comprising:

a light source that provides a therapeutic light suitable for the required treatment, see the and col. 1, lines 16-25; and

a light source segment **68** that that houses a laser light transmitting fiber **70**, said light source segment is of sufficiently small size and configuration so that it can be inserted through the urethra of the patient as presently claimed, see Figs. 1B, 4, and col. 3, lines 53-56.

As to claims 7 and 8, the non-implantable device further comprises at least one light-attenuating lens **94**.

As to claim 11, the device further comprises "a cylindrical tube bore **66** which defines a telescope passage for receiving an optical telescope **67** of the type conventionally used in endoscopic instruments," see col. 3, lines 49-52.

*Note: The U.S. Patent '507 to Costello et al. is directed to the treatment of prostate. However, it is known that obstructive prostate gland enlargement or tumor causes a constant dripping or leakage of urine, i.e., Overflow incontinence. Hence, the device of Costello et al. is adapted to treat urological disorders as presently claimed.*

3. Claims 11-14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank U.S. Patent No. 4,313,431.

Frank discloses a non-implantable endoscopic apparatus for irradiating bladder tumors in a patient with a laser light, the apparatus comprising: a viewing assembly (endoscope) for viewing a target site within said bladder; and a light source and light transmission means for delivering treatment light to said target site.

Although Frank does not particularly teach method step for carrying out the treatment, the method steps of the instant claims are inherent to the use of his treatment apparatus. Hence, Frank anticipates the claims as recited.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costello et al. in view of Tulip U.S. Patent No. 5,059,200 and Ganz U.S. Patent No. 6,491,618.

Costello et al., described above, fail to teach the parameters of the light, such as the pulse duration or wavelength/color of the treatment light. They further fail to teach the use of tungsten halogen lamp as the source of irradiation.

However, Tulip teaches an alternative, non-implantable, laser lithotripter for treating urological disorders, the lithotripter comprising a pulsed light source having a pulse-width and wavelength as recited in the instant claims, see col. 7, lines 4-35. Ganz also teaches an alternative treatment device for treating urinary tract disorders by irradiation, the device comprising a tungsten halogen lamp as the source of radiation, see col. 2, lines 9-15 and col. 10, lines 39-54.

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Costello et al. in view of Tulip and Ganz and use a pulsed or continuous wave generated by a laser or an incandescent lamp as an equivalent alternative source to provide the treatment light.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,454,807 to Lennex et al. teaches a device for treating urological disorders by optical irradiation, see Figs. 7a and 7b, col. 8, lines 44-49.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (703) 305-5787. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

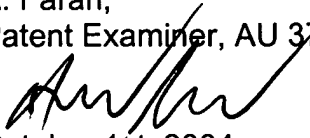
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Farah,  
Patent Examiner, AU 3739



October 1st, 2004